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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,229	01/26/2001	Takanori Iwamatsu	FUJS 13.045A	6938
26304	7590	02/22/2006	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP			TSE, YOUNG TOI	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	
			2637	

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,229

Applicant(s)

IWAMATSU ET AL.

Examiner

YOUNG T. TSE

Art Unit

2637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Reissue Applications

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 20, 2005 has been entered.

Response to Arguments

2. Applicant's arguments, see pages 17-21, filed on October 20, 2005, with respect to claim 47 have been fully considered and are persuasive. The rejection of claim 47 has been withdrawn.

3. Applicant's arguments filed on October 20, 2005 have been fully considered but they are not persuasive.

Applicants argue that the newly-added claim 47 is submitted with the present reissue to correct this error and claim 47 is a linking claim that encompasses both the elected group of the issued claims 1-14 and one or more non-elected species described in the specification. The Applicants further give an example of the newly added claim 47 includes the elected group covered by claims 1-14 (e.g., "between input and output signals of said equalizing circuit" recited in claim 1), which the Examiner identified as a

species illustrated by Fig. 1 and its corresponding description in the specification.

Applicants further argue that the above-cited recitation of claim 47 is generic to the elected species and at least two non-elected species, which were identified by the Examiner to be illustrated by Figs. 2 and 3, respectively.

The examiner respectively disagrees. Although claim 47 recites the common claimed subject matter of an identifying circuit, a clock regenerating circuit, and a clock phase detecting section, as recited in the issued claims 1-14, none of the elected species of the issued claims 1-14 includes the claimed subject matter as recited in the newly added claim 47. For instance, claim 47 recites that the clock phase detecting section for detecting a phase component of signal identification clocks based on clock-phase-detecting composite input information including any one of (i) a combination of a demodulated signal which is obtained by demodulating a multilevel orthogonal modulated signal and an equalized demodulated signal and (ii) a combination of clock phase difference information to be supplied to the identifying circuit and signal error differential information obtained by the identifying circuit, and then supplying the phase component to the clock regenerating circuit, and the clock phase detecting section including a difference detecting unit responsive to the receipt of the composite input information, for detecting any one of (I) difference information between the demodulated signal and the equalized demodulated signal and (II) a combination of the clock phase difference information and the signal error differential information, and a clock phase calculating unit for calculating the phase component of said signal identification clock based on the output from the difference detecting unit.

Therefore, none of the elected species of the issued claims 1-14 includes the claimed subject matter of an equalizing circuit, a difference detecting unit for detecting any one of the criteria (I) and (II) and a clock phase calculating unit for calculating the phase component of said signal identification clock based on the output from the difference detecting unit, as recited in the newly added claim 47.

4. The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414.

Applicants belief that an error has been made by reason of the patentees claiming less than they had the right to claim in the patent. In particular, the patentees concluded that a generic claim could have been included among the claims during prosecution of the elected species.

Had a generic claim been entered and allowed in the parent case, then following allowance of the elected claims, the examiner would have examined a reasonable number of additional species. Failure to have additional species examined in the parent case was the penalty paid for the error of omitting a generic claim. The reissue application has the objective of rectifying that error and defining a generic claim and thereby also cover hopefully all species that were originally claimed in the parent application.

The newly added claim 47 recites the common claimed subject matter of an identifying circuit, a clock regenerating circuit, and a clock phase detecting section, as

recited in the issued claims 1-14, none of the elected species of the issued claims 1-14 includes the claimed subject matter as recited in the newly added claim 47. For instance, claim 47 recites that the clock phase detecting section for detecting a phase component of signal identification clocks based on clock-phase-detecting composite input information including any one of (i) a combination of a demodulated signal which is obtained by demodulating a multilevel orthogonal modulated signal and an equalized demodulated signal and (ii) a combination of clock phase difference information to be supplied to the identifying circuit and signal error differential information obtained by the identifying circuit, and then supplying the phase component to the clock regenerating circuit, and the clock phase detecting section including a difference detecting unit responsive to the receipt of the composite input information, for detecting any one of (I) difference information between the demodulated signal and the equalized demodulated signal and (II) a combination of the clock phase difference information and the signal error differential information, and a clock phase calculating unit for calculating the phase component of said signal identification clock based on the output from the difference detecting unit.

Therefore, none of the elected species of the issued claims 1-14 includes the claimed subject matter of an equalizing circuit, a difference detecting unit for detecting any one of the criteria (I) and (II) and a clock phase calculating unit for calculating the phase component of said signal identification clock based on the output from the difference detecting unit, as recited in the newly added claim 47.

However, according to MPEP 1450 Restriction and Election of Species. A reissue applicant's failure to timely file a divisional application is not considered to be the error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such error is not correctable by reissue of the original patent under 35 U.S.C. 251. In re Watkinson, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); In re Orita, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1997). See also In re Mead, 581 F. 2d 251, 198 USPQ 412 (CCPA 1978). Likewise, if the original patent specification or the prosecution history of the original patent shows an intent not to claim the newly presented invention, that invention cannot be added by reissue.

5. Claims 1-14 and 47 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Drawings

6. The drawing of FIG. 14 has received on October 20, 2005. However, this drawing is not acceptable by the examiner because the label "Amended" on the top of FIG. 14 should not be included.

Claim Objections

7. Claims 1-14 and 47 are objected to because of the following informalities:

In line 3 and line 4 (first occurrence) of claims 1-2 and 8, "signal" should be "demodulated signal". See claim 2, line 15; claim 4, line 10; claim 8, line 15; claim 9, line 6; and claim 10, line 10.

Claims 3-7 and 9-14 are directly or indirectly depended upon claims 2 and 8.

In claim 47, line 10, "of demodulated signal" should be "of the demodulated signal".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 47 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The configuration of claim 47 does not correspond to the disclosure of the drawings. For example, claim 47 recites a clock phase detecting section for detecting a phase component of signal identification clocks based on clock-phase-detecting composite input information including any one of (i) a combination of a demodulated signal which is obtained by demodulating a multilevel orthogonal modulated signal and an equalized demodulated signal and (ii) a combination of clock phase difference

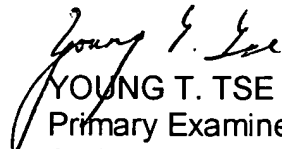
information to be supplied to the identifying circuit and signal error differential information obtained by the identifying circuit, and then supplying the phase component to the clock regenerating circuit, and the clock phase detecting section including a difference detecting unit responsive to the receipt of the composite input information, for detecting any one of (I) difference information between the demodulated signal and the equalized demodulated signal and (II) a combination of the clock phase difference information and the signal error differential information, and a clock phase calculating unit for calculating the phase component of said signal identification clock based on the output from the difference detecting unit.

However, none of the Figures shows that a clock phase detecting section for detecting a phase component of signal identification clocks based on clock-phase-detecting composite input information including any one of the criteria (i) and (ii) and the clock phase detecting section includes the combination of a difference detecting unit for detecting any one of the criteria (I) and (II) and a clock phase calculating unit for calculating the phase component of said signal identification clock based on the output from the difference detecting unit, as recited in the newly added claim 47.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOUNG T. TSE whose telephone number is (571) 272-3051. The examiner can normally be reached on Monday-Thursday and alternative Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel can be reached on (571) 272-2988. The Central FAX Number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


YOUNG T. TSE
Primary Examiner
Art Unit 2637